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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,835	09/30/2004	Pascale Adolphine Emilienne De Meuter	7393/84118	1058

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EXAMINER	
DEES, NIKKI H	
ART UNIT	PAPER NUMBER
1794	
MAIL DATE	DELIVERY MODE
04/04/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/509,835	DE MEUTER ET AL.	
	Examiner	Art Unit	
	Nikki H. Dees	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 February 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The amendment filed on February 15, 2008, has been entered. Claims 9 and 10 have been added. Claims 1-10 are currently pending. Applicant failed to respond to 35 U.S.C. 101/112 rejections of claims 7 and 8. All rejections are maintained in the present action.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7-8 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd.* v. *Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 7-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 7-8 provide for the use of maltitol syrup, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 103

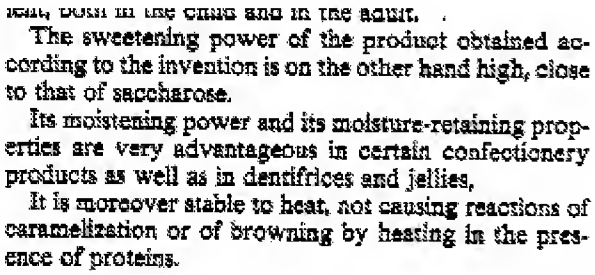
6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-4 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boursier (4,840,797) in view of Devos et al. (4,849,023).

8. Boursier teaches a maltitol syrup that is used for a sugarless hard coating for comestibles of both a confectionary and pharmaceutical nature (col. 1 lines 7-9, lines 41-42). Boursier goes on to give an example of a composition of a maltitol syrup used for this coating (col. 2 lines 53-57). Boursier also speaks to the maltitol syrup as having a concentration of dry matter from 50-70%. However, Boursier's example lists only DP 1-DP 3 components and not DP4.

9. Devos et al. teach a maltitol syrup containing DP 4+ products, including maltotetraitol (col. 4 lines 18-27). The syrup product of Devos et al. also has a dry matter content of greater than 65% (col. 4 line 43).

10. 
The sweetening power of the product obtained according to the invention is on the other hand high, close to that of saccharose.

Its moistening power and its moisture-retaining properties are very advantageous in certain confectionery products as well as in dentifrices and jellies.

It is moreover stable to heat, not causing reactions of caramelization or of browning by heating in the presence of proteins.

(column 5, lines 36+)

11. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted the maltitol syrup taught by Devos et al. for the maltitol syrup taught by Boursier for use in hard-coating of comestibles as the product has saccharose sweetening power, is useful in confections, and is heat stable.

12. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corriveau et al. (6,558,722) in view of Devos et al. (4,849,023).

13. Corriveau et al. speak directly to Applicants' claimed process for preparing sugar-free hard-coated comestibles. Corriveau et al. (col. 3 lines 22-23) list sugarless grossing syrups including maltitol. Further, it is noted that "greatest success is achieved when the compositions of the grossing syrup and the dry charge are compatible" (col. 3 lines 24-26). This would lead one of ordinary skill in the art to select a maltitol powder to coat the comestibles along with the previously selected maltitol grossing syrup.

14. Corriveau et al. place their centers (or cores) on a revolving pan (col. 3 line 40) during the coating process. This reads on Applicants' claim that the cores are in a moving bed of a coating apparatus.

15. Corriveau et al. disclose conditions for drying coated cores preferably at or below a of temperature 59ºF (or 15ºC) and a relative humidity of less than 50% (col. 4 lines 31-33). These conditions are not unlike the conditions Applicants' claim for drying of their coated cores.

16. The only matter of the Applicants' claims 5-6 on which Corriveau et al. are silent is the composition of the maltitol syrup in regards to DP.

17. As discussed above, Devos et al. teach a maltitol syrup containing DP 4+ products, including maltotetraitol (col. 4 lines 18-27). The syrup product of Devos et al. also has a dry matter content of greater than 65% (col. 4 line 43).

18. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the maltitol syrup having the composition disclosed by Devos et al. (col. 4 lines 18-27, 43) for the coating of the confections under the conditions disclosed by Corriveau et al.

19. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boursier (4,840,797) in view of Devos et al. (4,849,023). The Examiner interprets the claims as being a method of use for maltitol syrup having a DP4+ fraction from 0.7-1.5% weight in dry matter and a dry matter content of 68-72%. This syrup is then used to hard-coat comestibles. Boursier, as referenced above, teaches a maltitol syrup for use

in hard-coating both confections and pharmaceutical products. Devos, also as referenced above, discloses a maltitol syrup with DP4+ of 1% and dry matter higher than 65%. This reads directly on Applicants' claim of maltitol syrup with DP4+ from 0.7-1.5% and dry matter content of 68-72%.

Response to Arguments

20. Applicant's arguments filed February 15, 2008, have been fully considered but they are not persuasive.

21. Regarding claims 1-4, applicants argue that Boursier reference does not teach the dry matter content of the syrup of being from 68-72%.

22. In response, Table IV of Boursier teaches a syrup having a richness of 97% maltitol and a dry matter content of 70%. This is not only within applicant's claimed range of 68-72%, but touches applicant's preferred range from 70-72%.

23. Applicant goes on to argue (Remarks, p. 3) that the Boursier teaching would lead one of ordinary skill in the art to utilize a syrup of lower dry matter content. However, "a known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." See In re Gurley, 27 F.3d 551, 554, 31, USPQ 2d, 1130, 1132. MPEP 2145.02.

24. It is agreed that the Boursier reference does not teach maltitol syrups containing from 0.7 to 1.5 wt%DP_{4+}. However, Devos teaches maltitol syrups containing preferably from 87-97.5 wt% maltitol, and less than 1 wt% maltotetraitol and hydrogenated

products of higher molecular weight (DP_{4+}). Devos goes on to state that the product may be presented as a liquid product with a dry matter content of higher than 65% (col. 4 lines 41-44).

25. One of ordinary skill in the art at the time the invention was made could have used the syrup as taught by Devos with the reasonable expectation that it would be a suitable coating material. This would not have required undue experimentation on the part of the artisan.

26. New claims 9-10 are additionally rejected under Boursier in view of Devos for the reasons stated above and are included in the 103 rejection.

27. Regarding the 103 rejections of claims 7-8, applicants argue that the claimed invention provides unobvious advantages over Boursier in view of Devos.

28. In response, it is again noted that Boursier teaches a coating comprising a maltitol syrup having 70 wt % dry matter. Devos teaches a maltitol syrup with DP_{4+} of about 1%. One of ordinary skill would have had the reasonable expectation that the syrup of Devos would have been a suitable coating agent as taught by Boursier.

29. Regarding the rejections of claims 5-6, applicants argue that the examiner is using hindsight to combine the references.

30. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon

hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

31. The knowledge of coating of comestibles with maltitol syrup as claimed by Applicant's was known in the art before Applicant's invention, as taught by Corriveau. A maltitol syrup containing between 0.7 and 1.5 wt % DP_{4+} fraction was also known before Applicant's invention, as taught by Devos. One of ordinary skill could have utilized the syrup as taught by Devos in the coating process as taught by Corriveau with the reasonable expectation that it would provide a smooth coating for comestibles.

Conclusion

32. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikki H. Dees whose telephone number is (571) 270-3435. The examiner can normally be reached on Monday-Friday 7:30-5:00 EST (first Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carol Chaney/
Supervisory Patent Examiner, Art Unit 1794

Nikki H. Dees
Examiner
Art Unit 1794